

REMARKS

Claims 11-14 and 19-34 are pending in this application. By this Amendment, claim 11 is amended and claims 12, 14, 32, and 34 are canceled. Support for the amendments to the claims may be found, for example, in the specification. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Rejections Under 35 U.S.C. §112

A. §112, Second Paragraph

The Office Action rejects claims 11-14 and 19-34 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. By this Amendment, claim 11 is amended with particular attention to the Examiner's comments. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. §112, First Paragraph

The Office Action rejects claims 11-14 and 19-34 under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. By this Amendment, claims 12, 14, 32, and 34 are canceled, rendering their rejection moot. As to the remaining claims, Applicant respectfully traverses the rejection.

To provide written description for a claim, the specification as originally filed must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventors were in possession of the invention as claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

Claim 11 is directed to a wafer-holding carrier wherein "the total area of the polishing agent-passing holes occupies more than 20% and 30% or less of a main surface of the carrier." The lower limit of "more than 20%" is within the range of "15% or more" and "30% or less"

disclosed in the specification. *See* specification pages 4 and 5. Such a disclosure would clearly be considered by persons skilled in the art to be part of the Applicant's invention. Moreover, Examples 1 and 2 and Comparative Examples 1 and 2 demonstrate that as for the occupied area ratio of the polishing agent-passing holes, the greater, the better (up to 30%). *See* specification pages 14-16. In Example 2, when the occupied area ratio of polishing agent-passing holes was made to be 28.6%, flatness could be further improved as compared with Comparative Examples 1 and 2 in which each ratio was less than 15%, and Example 1 in which the ratio was less than 20%. From this data, persons skilled in the art would clearly consider the range of "more than 20% and 30% or less" to be fully supported by the written description.

In addition to these facts, the case law overwhelmingly supports the Applicant's compliance with the written description requirement. *See, e.g., In re Blaser, Germscheid and Worms*, 194 USPQ 122, 125 (CCPA 1977) (a disclosed 25-60% range supports claimed 35-60% range); *In re Wertheim*, 191 USPQ 90, 98 (CCPA 1976) (a disclosed 25-60% range with specific embodiments at 36% and 50% supports claimed 35-60% range). Furthermore, public policy does not support the current reasoning asserted in the Office Action:

If, when [applicants] yield any part of what they originally believed to be their due, they substitute a new "invention," only two courses will open to them: they must at the outset either prophetically divine what the art contains, or they must lay down a barrage of claims, starting with the widest and proceeding by the successive incorporation of more and more detail, until all combinations have been exhausted which can by any possibility succeed. The first is an impossible task; the second is a custom already honored in the breach than in the observance, and its extension would only increase that surfeit of verbiage which has for long been the curse of patent practice, and has done much to discredit it. *It is impossible to imagine any public purpose which it could serve.*

(Emphasis added). See *Engineering Development Laboratories v. Radio Corp. of America*, 68 USPQ 238, 241-242 (2d Cir. 1946) (quoted with approval in *In re Driscoll*, 195 USPQ 434, 438 (CCPA 1977)).

Moreover, the burden of presenting evidence of failure to comply with the written description has not been met. A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. Specifically, the Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in the specification a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). The Office Action simply states that "'more than 20%' as a lower limit of acceptable hole size, is deemed to constitute new matter." No evidence has been presented and, as such, the required burden has not have been met.

II. Rejection Under 35 U.S.C. §102(b)

The Office Action rejects claims 11, 12, 19, 23, 27, 31, and 32 under 35 U.S.C. §102(b) as being anticipated by JP 10-180623 to Susumu et al. ("Susumu"). By this Amendment, claims 12 and 32 are canceled, rendering their rejection moot. As to the remaining claims, Applicant respectfully traverses the rejection.

Independent claim 11 is directed to "a wafer-holding carrier which is used when holding wafers between an upper turn table and a lower turn table to which polishing pads are attached, and polishing both sides of the wafers by a polishing agent, wherein the carrier has polishing agent-passing holes for passing the polishing agent through as well as wafer-holding holes for containing and holding the wafers, and the total area of the polishing agent-passing

holes occupies *more than 20% and 30% or less* of a main surface of the carrier" (emphasis added). Susumu does not teach such features.

In contrast to the present application, Susumu is directed to a wafer-holding carrier used in a lapping process, not a polishing process as in the present claims. Even if the processes were the same, the ranges of the hole areas in Susumu and the present application are different. In Susumu, an area of through holes is set between 0.8% and 20% of the hole surface area of the carrier.

Furthermore, Susumu teaches away from the claimed invention. Susumu teaches that area ratios over 20% lower the mechanical strength of the carrier and result in imperfect holes and cracking. The Office Action asserts that Figure 4 reveals that hole size ratios greater than 20% were produced and/or conceived. However, Susumu in Figure 4 actually teaches that the occupied area of ratio of holes must not be over 20%. Therefore, Susumu teaches away from the present invention in which the occupied area of ratio of holes is more than 20%.

The Office Action also asserts that the Applicant's specification is completely silent as to any criticality of the hole size ratio being "more than 20%," and that it appears from the Applicant's specification that values as low as 15% would work equally well as values somewhat greater than 20%. However, in Example 2, when the occupied area ratio of polishing agent-passing holes was made to be 28.6%, flatness could be further improved as compared with Comparative Examples 1 and 2 in which each ratio was less than 15%, and Example 1 in which the ratio was less than 20%.

Susumu does not teach all the features of claim 11. Therefore, claim 11 is not anticipated by Susumu. Claims 13, 19-31, and 33 depend from claim 11 and, thus, also are not anticipated by Susumu. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejections Under 35 U.S.C. §103(a)

The Office Action rejects claims 11, 12, 19, 23, 27, 31, and 32 under 35 U.S.C. §103(a) as obvious over Susumu; and rejects claims 20, 22, 24, 26, 28 and 30 as obvious over Susumu in view of JP 10-202511 to Fuminari et al. ("Fuminari"). By this Amendment, claims 12, 14, 32 and 34 are canceled, rendering their rejection moot. As to the remaining claims, Applicant respectfully traverses the rejection.

As discussed above, Susumu fails to teach or suggest all of the features of independent claim 11 and, thus, would not have rendered obvious claim 11. Despite its asserted disclosures, Fuminari fails to cure the deficiencies of Susumu. Therefore, Susumu and Fuminari, either separately or combined, fail to teach or suggest all of the features of claim 11.

Claim 11 would not have been obvious by Susumu and Fuminari. Claims 13, 19-31, and 33 variously depend from claim 11 and, thus, also would not have been rendered obvious by Susumu and Fuminari. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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